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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/922,753

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Gregg Freishtat

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EXAMINER

GORT, ELAINE L

ART UNIT

PAPER NUMBER

3687

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/922,753	<b>Applicant(s)</b> FREISHTAT ET AL.	
	<b>Examiner</b> Elaine Gort	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/12/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 69 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 69 recites only an insignificant extra-solution activity, or nominal recitation of a patentable subject matter which does not transform an unpatentable principle (e.g. Software) into a patentable process. Mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible, and “insignificant postsolution activity will not transform and unpatentable principle into a patentable process.” Diehr 450 U.S. 191-192. See Bilsky 88 USPQ2d 1394. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process under section 101. Benson 409 U.S. at 71-72. A general purpose computer is not a particular machine, and thus innovative software processes are unpatentable if they are tied only to a general purpose computer and an “incidental physical limitation, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process”. Langemyr Appeal 2008-1495, p 20-21.

The only recitation(s) of structure is/are recitation of a computer within a network of computers which is/are found to be insignificant extra-solution activity.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not clearly convey that the information provided to a sales associate is previously determined to be effective in closing a sale given sales associate information associated with the selected sales associate.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is unclear in claim 69 lines 8, 10, 13, 18, 30, 31 and 36 regarding “a computer”. It is unclear if this is relating to the computer recited in line 3 or is claiming additional 2<sup>nd</sup>, 3<sup>rd</sup>, 4<sup>th</sup>, 5<sup>th</sup>, 6<sup>th</sup> and so on... computers. It is not clear if these functions are being carried out on one computer or on different computers within the network of computers.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. (US Patent 6,760,429) in view of Bunting et al. (US Patent 6,134,530) and Gross (US 2002/0004735 A1).**

Bunting et al. discloses the claimed method for selling goods and services in conjunction with the Internet, comprising the following being carried out by a computer or computers within a network:

Receiving session information from a website about a customer session on the website, the website being associated with a selected enterprise from a plurality of enterprises and the session information comprising one or more products a customer is searching using a browser application executing on a customer computer (such as customer's query including products on a company's webpage 508, see figure 5, column 6 lines 21 and 23, and column 9 lines 14+. Note: the Internet inherently has websites from a plurality of enterprises on it.);

Receiving customer information associated with the customer from the selected enterprise (such as customer's information, column 6 line 27);

Executing a matching engine to determine one or more desirable sales associates from among a plurality of sales associates for the customer based on the

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session information, the customer information and the sales associate information associated with each of the plurality of sales associates (such as when the system determines the “appropriate agent” or assigns an agent, 518 fig 5. Examiner notes that in order to connect a customer with an “appropriate” agent the system must have information on the agents in order to make this determination, column 2 line 35. In the alternative see teaching below of Bunting regarding employee profile data used to make matches);

Transmitting a signal to a computer associated with a selected one of the one or more desirable sales associates in order to notify the selected sales associate that the sales opportunity regarding the customer exists (for example, selected agent station computer 522 receives customer information when it apprises the agent of the customer information, the content provided the customer and then connects the agent to the customer, column 9 line 55);

Facilitating communication for a sales transaction between the customer computer (e.g. 502) and the computer associated with the selected sales associate (e.g. 522) via the Internet (e.g. 520, see figure 5);

Receiving sales information (for example, customer 502 receives sales information from the advertising server 516 while they wait, column 9 line 34);

Retrieving from a database of collateral sales material, information previously determined to be effective in closing a sale given the customer information and the one or more products the customer is searching (sales agent can retrieve via their computer sales information that inherently was previously determined to be effective in closing a

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sale given the associates profile, the customer's information and the customer's session information

**But does not clearly disclose:**

Determining from the session information and the customer information that the customer constitutes a sales opportunity appropriate for sales assistance;

Matching calls to sales associates using sales associate information; and

Where the information provided to sales associates found to be effective in closing a sale is based on sales associate information associated with the selected sales associate.

Bunting teaches that it is old and well known in the art of service routing systems to identify a sales opportunity appropriate for sales assistance based on session information and customer information (for example, column 4 line 58+ teaches determining a cross-sell opportunity based on the customers profile and actions, construed as customer information and session information) and to use sales associate information to determine an appropriate agent (employee profile, column 9 line 29+).

Gross teaches that it is old and well known in the art of sales to provide sales representatives with information relating to estimates of the commissions that they will make on a sale [0008].

Therefore it would have been obvious to one of ordinary skill in the art to modify Hung et al. to determine that a sales opportunity exists for an appropriate sales assistance and matching calls to associates based on sales associate information as taught by Bunting in order to determine an appropriate sales agent to assist the

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customer; and to use selected sales associate information, such as potential commissions, to determine information effective in closing a sale in order to provide sales agents with agent specific information, such as their estimated commission.

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 69 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

Elaine Gort  
Primary Examiner  
Art Unit 3687

July 17, 2009